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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BENSON et al.

Application No.: 09/679,948

Filed: November 4, 2000

For: System and Method for Manipulating  
Digital Images

Examiner: Good Johnson, Motilewa

Art Unit: 2672

RESPONSE TO OFFICE ACTION

I certify that this document was sent by fax  
to USPTO at 703-872-9314 on June 18 2003

Bao Tran

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sirs:

The Office Action mailed March 2003 rejected claims 1-45 were rejected under Section 103(a) as unpatentable over Ofoto.com in view of Bowman-Amuah (USPN 6,477,580). Applicants respectfully traverse the rejections and respectfully submit that all claims are in condition for allowance.

The §103 Rejection

Claims 1-45 were rejected over Ofoto in view of Bowman-Amuah. The Office Action asserted, among others, that Ofoto discloses:

editing the photo, Help: Ofoto Now 2.1, page 2, and discloses altering a copy of the photo rather than the original photo, Help: Ofoto Now 2.1, page 5; and synchronizing the local client computer and remote server ... Ofoto discloses uploading the photo on the remote server from the local client, Help: Ofoto Now 2.1, pages 6-7. Page 3 of Office Action.

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The Office Action here admits that Ofoto is contrary to the teaching of the instant invention. Here, Page 5 specifically noted that:

When you have used the Trim tool, OfotoNow will ask if you want to save your photo before you do anything else. If you don't want to save your changes, you don't have to. Remember: Using the Save command on the trimmed photo permanently alters the original photo! If you are not sure, work on a copy of the photo rather than the original, or use the Save As command to save a copy of the trimmed photo under a new name, leaving the original photo untouched. Red Eye.

Ofoto requires the user to work on a copy of the photo rather than the original because saving the change permanently alters the original photo. In contrast, Claim 1 recites "manipulating either locally or remotely parameters associated with the image without modifying the image itself; and synchronizing the local client computer and the remote server including updating metadata for one of the local client computer and the remote server using metadata of the other."

In one example, the user "alters" the appearance of the image by changing one or more parameters associated with the image. Only the parameters are then recorded as metadata and the image itself is not modified. For subsequent viewing, the parameters are applied to the original image to arrive at the altered image. Hence, the invention does not modify the image but records the parameters to be subsequently applied to the original image to recreate the altered image. In contrast, Ofoto actually modifies the image and, if the user overwrites the original image with the altered image, the original image is lost. Hence, Ofoto recommends that the user saves the altered image as a different file. Thus, Ofoto cannot manipulating either locally or remotely parameters associated with the image without modifying the image itself.

Additionally, as admitted in the rejection, Ofoto is absolutely silent on synchronizing the local client computer and the remote server including updating metadata for one of the local client computer and the remote server using metadata of the other. There is no suggestion that this be done in Ofoto because Ofoto does not need to use metadata. Rather, each altered image is saved as a separate, stand-alone file and there is no need for metadata to build the altered image from the original image.

Applicant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rhehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the Ofoto reference, Bowman-

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Amuah, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. §2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in appellant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991).

Here, the criteria have not been met: there is absolutely no suggestion or motivation; there is no expectation of success for the modification, and a plurality of claim limitations are missing.

The office action noted that "Bowman-Amuah discloses sending messages between a sending system and a receiving system and attaching meta-data to the message. Bowman-Amuah further discloses the data include identifiers for a type of object, attribute descriptors, and metadata interpretations, col. 2, lines 19-43." The cited section, the Summary of the Invention, merely shows:

A system, method, and article of manufacture are described for providing a self-describing stream-based communication system. Messages are sent including data between a sending system and a receiving system. Meta-data is attached to the messages being sent between the sending system and the receiving system. The data of the messages sent from the sending system to the receiving system is translated based on the meta-data. The meta-data includes a first section that identifies a type of object associated with the data and a number of attribute descriptors in the data and a second section that includes a series of the attribute descriptors defining elements of the data.

In one embodiment of the present invention, the sending system and receiving system may each be equipped with logic for interpreting the meta-data of the messages. In an additional embodiment of the present invention, the elements may be defined in terms of size, type, and name.

In another embodiment of the present invention, one of the systems may be an object-based system and one of the systems may be a non-object-based system. In a further embodiment of the present invention, both of the systems may be object-based systems. In even yet another embodiment of the present invention, both of the systems maybe non-object-based systems.

Although metadata is mentioned, Bowman-Amuah does not show the specifics of "synchronizing the local client computer and the remote server including updating metadata for one of the local client computer and the remote server using metadata of the other."

Here, exemplary operations in one embodiment of the synchronizing operation as disclosed in the instant application are reproduced below:

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Synchronization is performed between the client computer 104 and server computer 102 to ensure a seamless experience for the user. No matter where data is manipulated, whether account, order or image data, either locally or remotely, a synchronization process is executed to allow both remote and local processes to be current.

As described above, synchronization occurs each time a connection to the user's account at the online photofinisher's website is made. State information of the user account is updated on the user computer and on the web. The state information can include image transfers or upload, the transfer of the image file name, image processing information, image archival information, annotation and back printing information, UI state information, personal template, order information. In one implementation, any input information on the user's computer will be automatically uploaded to the user account on the web without requiring the user to log onto the website. Specification at page 14.

The cited section of Bowman-Amuah merely shows transmission of metadata. However, it does not show the specifics of independent claim 1 with respect to the synchronizing operation. Hence, this is yet another independent basis for traversing the Section 103 rejection.

The dependent claims are allowable since they depend from allowable independent claims. Moreover, they are allowable since neither Ofoto nor Bowman-Amuah shows the specifics as recited in the dependent claims.

In sum, since Bowman-Amuah does not show the claimed elements recited in claim 1, Applicants submit that neither can render obvious any of the independent claims. The dependent claims are allowable since they depend from allowable independent claims.

With respect to the remaining independent claim 43, Bowman does not show additional details of:

43. A method for distributing image editing, review and ordering functions among system resources in an image-processing system, the image-processing system including a local client computer and a remote server, the method comprising:

Determining if a session is open between the local client computer and the remote server;

Capturing, at the client computer when the session is closed, metadata describing any manipulations by the user of an image;

Capturing, at the remote server when the session is opened, metadata describing manipulations of the image by the user; and

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Synchronizing the metadata captured at each of the local client computer and the remote server when the session is open.

Similarly, Bowman-Amuah cannot anticipate claim 44 as it lacks details of image management, archival and printing as follows:

44. A method for distributing image editing, review and ordering functions among system resources in an image-processing system, the image-processing system including a local client computer and a remote server, the method comprising:

Dividing image management, archival, and printing functions among the local client computer and the remote server including performing image management at either of the local client computer and the remote server, and performing image archive and printing functions at the remote server; and

Synchronizing image management data between the local client computer and the remote server.

Additionally, Bowman-Amuah lacks the specifics claimed in claim 45:

45. An apparatus for manipulating a digital image comprising:

Client software for executing on a local client computer including instructions for

identifying an original image for processing at the local client computer,

uploading the original image to a remote server,

receiving a user selection to locally or remotely process the original image;

if local processing is selected, locally manipulating parameters associated with the original image including storing, on the local client computer, metadata describing the manipulations without modifying the original image,

if remote processing is selected, opening a session with the remote server; and

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Remote server software for executing on the remote server including instructions for

receiving the original image,

manipulating parameters associated with the original image in accordance with instructions received from the local processor

storing metadata describing the manipulations without modifying the original image, and

at each session between the local client computer and the remote server, synchronizing the local client computer and the remote server including updating metadata for one of the local client computer and the remote server using metadata of the other.

#### CONCLUSION

Applicants respectfully submit that all claims are in condition for allowance. Withdrawal of the rejection is respectfully requested. If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



Bao Tran

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